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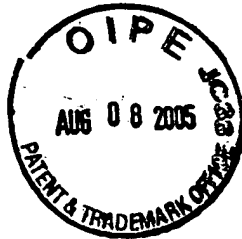
Docket Number: 1005.10
Customer No.: 53953

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Taylor, Billy P.

Serial No. 09/690,677

Filed: October 16, 2000

For: METHOD AND SYSTEM FOR REPLACING
CONTENT IN A DIGITAL VERSION OF A
MASS- PRODUCED PRINTED PAPER§
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Examiner: Hartman Jr., Ronald D.

Group Art Unit: 2121

Confirmation No.: 3413

REQUEST FOR CERTIFICATE OF CORRECTION
UNDER 35 USC 254Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450Certificate
AUG 12 2005
of Correction

Sir:

Applicant hereby request a Certificate of Correction to correct a mistake in the above-identified patent as set forth on the attached forms PTO/SB/44. Attached for reference is a copy of a Response to Office Action dated January 29, 2004, with claim 18 (issued as claim 20) as currently amended.

As submitted, claim 18 is dependent on claim 13. As issued, claim 20 is dependent on claim 15. Currently, claim 20 is erroneously listed as dependent on 13.

Because the mistake was incurred through the fault of the Patent and Trademark Office, no fee is necessary.

Respectfully submitted,

Michael A. Davis, Jr.

Registration No. 35,488

Date: 8/04/2005
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Date

Rose K. Davis

AUG 15 2005

AUG 15 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION**

PATENT NO. : 6,845,273 B1

DATED : January 18, 2005

INVENTOR(S) : Billy P. Taylor

It is certified that error appears in the above-identified patent and that said Letters Patent
is hereby corrected as shown below:

Column 20, line 59, to and including column 20, line 62, Claim 20 should read:

--20. The computer-readable medium of claim 15 wherein the computer program is processable by the computer system for
causing the computer system to:
encrypt the second version.--.

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PATENT NO. 6,845,273 B1

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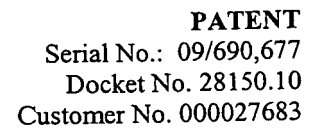


This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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AUG 15 2005



In re application of:
Billy P. Taylor

Serial No.: 09/690,677

Filed: October 16, 2000

For: METHOD AND SYSTEM FOR
REPLACING CONTENT IN A
DIGITAL VERSION OF A MASS-
PRODUCED PRINTED PAPER

[illegible]

Group Art Unit: 2121

Examiner: Liu, J.

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

In response to the Office Action mailed January 29, 2004, please reconsider this application in view of the following remarks.

Listing of Claims section begins on page 2 of this paper.

Remarks section begins on page 7 of this paper.

Listing of Claims

The following listing of claims will replace all prior versions, and listings, of claims in the application.

1. (Previously presented) A method performed by a computer system, comprising:

storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

2. (Previously presented) The method of Claim 1 wherein the translating comprises:

translating the first version into the second version, wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

3. (Previously presented) The method of Claim 2 wherein the translating comprises:

translating the first version into the second version, wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

4. (Previously presented) The method of Claim 1 wherein the translating comprises:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

5. (Original) The method of Claim 1 and comprising:
compressing the second version.

6. (Original) The method of Claim 1 and comprising:
encrypting the second version.

7. (Previously presented) A system, comprising:
a computing device for:

storing a first version of a mass-produced printed paper, the first version
including first displayable content at a particular location within the
paper; and

translating the first version into a second version of the paper in a manner that
replaces the first displayable content with second displayable content
at the particular location within the paper, the second version including
the second displayable content instead of the first displayable content
at the particular location within the paper, and the second version
being displayable on a display device as a likeness of the paper with
the second displayable content instead of the first displayable content
at the particular location within the paper.

8. (Previously presented) The system of Claim 7 wherein the first displayable
content is a first advertisement, and the second displayable content is a second advertisement.

9. (Original) The system of Claim 8 wherein the first advertisement is a national
advertisement, and the second advertisement is a regional advertisement.

10. (Previously presented) The system of Claim 7 wherein the computing device is for:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

11. (Original) The system of Claim 7 wherein the computing device is for: compressing the second version.

12. (Original) The system of Claim 7 wherein the computing device is for: encrypting the second version.

13. (Currently amended) A computer-readable medium ~~computer program product~~, comprising:

a computer program processable by a computer system for causing the computer system to:

store a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translate the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper; ~~and~~

~~an apparatus from which the computer program is accessible by the computer system.~~

14. (Currently amended) The computer-readable medium~~computer program~~ product of Claim 13 wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

15. (Currently amended) The computer-readable medium~~computer program~~ product of Claim 14 wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

16. (Currently amended) The computer-readable medium~~computer program~~ product of Claim 13 wherein the computer program is processable by the computer system for causing the computer system to:

translate~~translating~~ the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

17. (Currently amended) The computer-readable medium~~computer program~~ product of Claim 13 wherein the computer program is processable by the computer system for causing the computer system to:

compress the second version.

18. (Currently amended) The computer-readable medium~~computer program~~ product of Claim 13 wherein the computer program is processable by the computer system for causing the computer system to:

encrypt the second version.

19. (Previously presented) The method of Claim 1 wherein the translating comprises:

translating the first version into the second version, the first version having a first digital format, and the second version having a second digital format.

20. (Currently amended) The system method of Claim 7 wherein the first version has a first digital format, and the second version has a second digital format.

21. (Currently amended) The computer-readable medium method of Claim 13 wherein the first version has a first digital format, and the second version has a second digital format.

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 13-18, 20 and 21 have been amended. Claims 1-21 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims. Accordingly, no new matter has been entered.

Oath/Declaration

Under 37 CFR 1.33(a), the Office Action requested a complete post office address. Accordingly, with this paper, Applicant encloses a signed Letter Confirming Inventor's Post Office Address.

Objections

Claims 13-18, 20 and 21 have been amended to overcome the Office Action's objections thereto.

Rejection of the claims

The Office Action rejected claims 1, 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,231 ("Crandall") in view of PCT Patent Publication WO 00/30002 ("Sun").

Claim 1 recites:

1. A method performed by a computer system, comprising:
storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and
translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

Claim 7 recites:

7. A system, comprising:
a computing device for:
storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and
translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

As amended, Claim 13 recites:

13. A computer-readable medium, comprising:
a computer program processable by a computer system for causing the computer system to:
store a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and
translate the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

The Office Action acknowledged that Crandall fails to teach “translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper.”

Nevertheless, the Office Action asserted that, “it would have been obvious to one of

ordinary skill in the art to modify Crandell, in view of Sun Microsystems, by translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper.”

However, the Office Action failed to cite any evidence to suggest or teach such a modification of Crandall. Instead, the Office Action merely pointed to Sun at Fig. 5-6, page 14 lines 7-9, page 26 lines 4-16, and page 37 lines 13-24.

MPEP § 2143.01 states: “The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” As stated in MPEP § 2142, “...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...”

In fact, Crandall actually teaches away from its combination with Sun. For example, at col. 1, lines 15-28, Crandall states, “The current thinking of major publishing companies is to focus on creating an on-line edition for the world wide web. While the world wide web has been certainly gaining in popularity, the internet as it stands is too intricate for the average user to negotiate easily. The internet is especially frustrating to novist [sic] users trying to find articles or other information. It is estimated that there will be approximately ten million home pages by the end of 1996, thus increasing the difficulty of finding anything on the world wide web. It is evident by the fact that very few, if any, newspapers have been able to get sufficient loyal readers of electronic editions to charge access for them, i.e., the electronic editions are generally non-revenue generating items. *The World Wide Web is a dangerous place for the newspaper to be*” (emphasis added). Accordingly, the remainder of Crandall proceeds to teach a contrary technique.

In contradiction to Crandall, Sun’s specification revolves around web site advertisements that are transmitted from a web host to internet users or clients (*see, e.g.,* Sun’s Abstract and Summary). Moreover, the above-cited portions of Sun fail to even mention the words “translate” or “translation.” Accordingly, in this case, the cited aspects of

Crandall and Sun fail to teach, or even suggest, the desirability of the claimed combinations.

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In this case, the incentive or motivation (supporting the desirability of the claimed combinations) would arise solely from hindsight based on Applicant's teachings. Consequently, Crandall and Sun fail to provide any basis for combining in a 35 U.S.C. § 103 rejection.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a *prima facie* conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 7 and 13.

Dependent claims 2-6 and 19 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 8-12 and 20 depend from and further limit claim 7 and therefore are allowable.

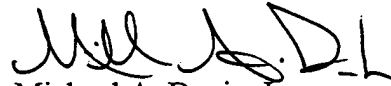
Dependent claims 14-18 and 21 depend from and further limit claim 13 and therefore are allowable.

An early formal notice of allowance of claims 1-21 is requested.

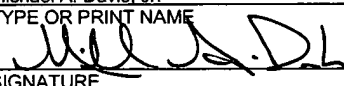
No additional fee is believed due. Nevertheless, to the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

Applicant has made an earnest attempt to place this case in condition for allowance.
If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the
telephone number listed below.

Respectfully submitted,


Michael A. Davis, Jr.
Registration No. 35,488

Date: 4/29/2004
HAYNES AND BOONE, LLP
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Docket No. 28150.10

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below:	
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April 29, 2004	
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19

additional operations. In addition to reading such functional descriptive material from computer-readable medium 212, computer 204 is capable of reading such functional descriptive material from (or through) network 116 which is also a computer-readable medium (or apparatus). Moreover, the memory device of computer 204 is itself a computer-readable medium (or apparatus).

Although illustrative embodiments have been shown and described, a wide range of modifications, change and substitution is contemplated in the foregoing disclosure and in some instances, some features of the embodiment may be employed without a corresponding use of other features. Accordingly, it is appropriate that the appended claims be construed broadly and in a manner consistent with the scope of the embodiments disclosed herein.

What is claimed is:

1. A method performed by a computer system, comprising:

storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

2. The method of claim 1 wherein the translating comprises:

translating the first version into the second version, wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

3. The method of claim 2 wherein the translating comprises:

translating the first version into the second version, wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

4. The method of claim 1 wherein the translating comprises:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

5. The method of claim 1 and comprising:

compressing the second version.

6. The method of claim 1 and comprising:

encrypting the second version.

7. The method of claim 1 wherein the translating comprises:

translating the first version into the second version, the first version having a first digital format, and the second version having a second digital format.

8. A system, comprising:

a computing device for:

storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location

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within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

9. The system of claim 8 wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

10. The system of claim 9 wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

11. The system of claim 8 wherein the computing device is for:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

12. The system of claim 8 wherein the computing device is for:

compressing the second version.

13. The system of claim 8 wherein the computing device is for:

encrypting the second version.

14. The system of claim 8 wherein the first version has a first digital format, and the second version has a second digital format.

15. A computer-readable medium comprising:

a computer program processable by a computer system for causing the computer system to:

store a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translate the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

16. The computer-readable medium of claim 15, wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

17. The computer-readable medium of claim 16 wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

18. The computer-readable medium of claim 15 wherein the computer program is processable by the computer system for causing the computer system to:

translate the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

19. The computer-readable medium of claim 15 wherein the computer program is processable by the computer system for causing the computer system to:

compress the second version.

20. The computer-readable medium of claim 13 wherein the computer program is processable by the computer system for causing the computer system to:

encrypt the second version.

21. The computer-readable medium of claim 15 wherein the first version has a first digital format, and the second version has a second digital format.

* * * * *

AUG 15 2005

What is claimed is:

1. A method performed by a computer system, comprising:

storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

2. The method of ~~Claim~~claim 1 wherein the translating comprises:

translating the first version into the second version, wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

3. The method of ~~Claim~~claim 2 wherein the translating comprises:

translating the first version into the second version, wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

4. The method of ~~Claim~~claim 1 wherein the translating comprises:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

5. The method of ~~Claim~~claim 1 and comprising:

compressing the second version.

6. The method of ~~Claim~~claim 1 and comprising:

encrypting the second version.

7. The method of ~~Claim~~claim 1 wherein the translating comprises:

translating the first version into the second version, the first version having a first digital format, and the second version having a second digital format.

8. A system, comprising:

a computing device for:

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storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

9. The system of ~~Claim~~claim 8 wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

10. The system of ~~Claim~~claim 9 wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

11. The system of ~~Claim~~claim 8 wherein the computing device is for:

translating the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

12. The system of ~~Claim~~claim 8 wherein the computing device is for:

compressing the second version.

13. The system of ~~Claim~~claim 8 wherein the computing device is for:

encrypting the second version.

14. The system of ~~Claim~~claim 8 wherein the first version has a first digital format, and the second version has a second digital format.

15. A computer-readable medium, comprising:

a computer program processable by a computer system for causing the computer system to:

store a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and

translate the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

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16. The computer-readable medium of ~~Claim 15~~claim 15, wherein the first displayable content is a first advertisement, and the second displayable content is a second advertisement.

17. The computer-readable medium of ~~Claim~~claim 16 wherein the first advertisement is a national advertisement, and the second advertisement is a regional advertisement.

18. The computer-readable medium of ~~Claim~~claim 15 wherein the computer program is processable by the computer system for causing the computer system to:

translate ~~translating~~ the first version into the second version in a manner that replaces the first displayable content with the second displayable content in response to a user profile.

19. The computer-readable medium of ~~Claim~~claim 15 wherein the computer program is processable by the computer system for causing the computer system to:

compress the second version.

20. The computer-readable medium of ~~Claim 15~~claim 13 wherein the computer program is processable by the computer system for causing the computer system to:

encrypt the second version.

21. The computer-readable medium of ~~Claim~~claim 15 wherein the first version has a first digital format, and the second version has a second digital format.

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